

REMARKS

Upon entrance of the present amendment, claims 1, 3-5, 9-11, and 15-41 will be pending. Applicant respectfully requests that claims 29-37 be rejoined in accordance with M.P.E.P. § 821.04. Applicant thanks the Examiner for the interview of June 9, 2004 regarding revocation of a previous final action.

I. EXPLANATION OF AMENDMENTS

The amendment to the claims introduces no new matter, and finds support throughout the specification as filed. Amended claims 1 and 2 find support in claims 1, 2, and 8 and in the specification at page 11, lines 15-30, and page 16, lines 1-4, 23-24 and 28-31, and page 20, line 11, to page 21, line 10. Claims 2, 7, and 8 have been canceled in view of the amendment to claim 1. Claims 3, 23, 24, 29 and 34 have been amended in view of the amendment to claim 1; claims 29 and 34 amended so as to allow rejoinder under M.P.E.P. § 821.04. Claims 39 and 40 have been amended to emphasize that the particular material is greater than 0% by volume of the solid-aggregate materials. Further discussion of the amended claims is provided herein.

II. THE CITED REFERENCES DO NOT SUPPLEMENT THE DEFICIENCIES IN KRALL '287. ACCORDINGLY, THE CLAIMS ARE PATENTABLE AND NONOBVIOUS

In paragraphs 3-14 of the Office Action, the Office rejected claims as allegedly unpatentable over WO 00/44287 ("Krall '287") in view of various references under 35 U.S.C. § 103(a). The Applicant respectfully traverses, because the Office has failed to establish a *prima facie* case of obviousness for the claims as presently amended.

Specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." M.P.E.P. §§ 2142, 2143. As shown below, Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness for amended claim 1.

A. Evans '361 Cannot Be Combined With Krall '287 To Render The Claims Obvious

In paragraphs 4-10 of the Office Action, the Office rejected claims 1-5, 7-11, 15-21, and 23-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over '287 in view of "Evans," U.S. Pat. No. 5,702,361.

Claim 1 has been amended to recite a polymeric non-cyanoacrylate rheology modifying agent having an average molecular weight greater than 200,000. Neither '287 nor '361 disclose a non-cyanoacrylate rheology modifying agent comprising a polymeric compound having an average molecular weight greater than 200,000. Evans discloses cellulose diacetate compositions having an average molecular weight up to, but not equal to or greater than 200,000. (Evans, col. 5, lines 48-51.) As admitted by the Office in the previous action (at page 7), Krall '287 fails to teach the use of polymeric non-cyanoacrylate rheology modifying agents. Therefore, this rejection does not meet the criteria of § 2143 and has been rendered moot in view of the amendment to claim 1 as described above.

B. U.S. Pat. No. 5,447,710 Cannot Be Combined With Krall '287 To Render The Claims Obvious

In paragraphs 11-13 of the Office Action, the Office rejected claims 1-3, 9-11, and 15-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over '287 in view of "Na," U.S. Pat. No. 5,447,710.

Na also fails to teach or suggest a polymeric non-cyanoacrylate modifying agent comprising a polymeric compound having an average molecular weight greater than 200,000. While Na does disclose certain surfactants with molecular weights in excess of 4000, such surfactants are provided for absorption to a X-ray contrast agent and not as polymeric non-cyanoacrylate rheology modifying agents. Therefore, this rejection has also been rendered moot in view of the amendment to claim 1 as described above.

C. Krall '366 Cannot Be Combined With Krall '287 To Render The Claims Obvious

In paragraph 14 of the Office Action, the Office rejected claims 1-3, 9-10, 15-21, and 23-28 under 35 U.S.C. § 103(a) as allegedly unpatentable over '287 in view of "Krall '366," U.S. Pat. No. 6,037,366.

Krall '366 also fails to teach or suggest a non-cyanoacrylate modifying agent comprising a polymeric compound having an average molecular weight greater than 200,000.

Therefore, this rejection has been rendered moot in view of the amendment to claim 1 as described above.

Accordingly, the rejections under § 103(a) have been rendered moot or remain improper for failure of the Office to establish a *prima facie* case of obviousness. The rejections should be withdrawn.

III. THE OBJECTIONS TO CLAIMS 39 AND 40 HAVE BEEN RENDERED MOOT

The Office objected to claim 39 and 40 because they allegedly did not require the existence of inorganic particulate material. That objection has been rendered moot in view of the amendment of these claims to specify the presence of such material in amounts greater than 0% by volume of the solid-aggregate materials. Accordingly, the objection should be withdrawn.

IV. HECHENBERGER FAILS TO ANTICIPATE THE CLAIMS

In paragraph 15, the Office rejected claims 1, 3-5, 7-11, 15-16, 19, 26-27, 30, and 38-41 under 35 U.S.C. § 102(b) as allegedly anticipated by "Hechenberger," (U.S. Patent No. 4,997,861). Applicant respectfully traverses. To anticipate, a reference must disclose every element of a claim. Applicant's claim 1 recites a composition comprising a plasticizer and a radiopacifier. Hechenberger fails to teach a composition comprising a plasticizer, and also fails to teach a composition comprising a radiopacifier. Accordingly, the rejection is improper and should be withdrawn.

CONCLUSION

The Applicant respectfully submits that claims 1, 3-5, 9-11, and 15-41 are in condition for allowance. The Office is invited to contact the undersigned at the telephone number listed below in order to discuss any remaining issues or matters of form that will move this case to allowance.

While no fees are believed due, the amendment transmittal letter attached herewith permits the Director to charge any additional, necessary fees.

Respectfully submitted,

By:



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Dated: August 13, 2004